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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,977	02/08/2002	Chunhua Yan	CL001313	9919

25748 7590 07/01/2003

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EXAMINER
RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
1652	8

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/067,977	YAN ET AL.	
	Examiner	Art Unit	
	Manjunath N. Rao, Ph.D.	1652	

-- The MAILING DATE of this communication appears on the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4,8,9 and 24-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4,8,9 and 24-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claims 4, 8, 9, 24-37 are currently pending in this application.

Election/Restrictions

Applicant's election of Group III, original claims 4-6, 8-11, 22-23 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Applicants have added new claims 24-37 directed to the elected group.

Drawings

Drawings submitted in this application are accepted by the Examiner for examination purposes only.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 25 and 27 are indefinite in the recitation of "having a nucleotide sequence consisting of". The scope of claimed polynucleotides is unclear because the claims recite the term "having", which, according to MPEP § 2111.03, can be interpreted as open or closed claim language and is typically interpreted as open claim language in claims drawn to

nucleic and amino acid sequences and further recite "consisting of", which, according to MPEP § 2111.03, is closed claim language. It is noted that if the term "having" in claim 25 were interpreted as using open claim language, claims 25 and 26 would be identical in scope and claim 26 would therefore be a duplicate of claim 25. For this reason, it appears that applicant intends for the term "having" to be interpreted as closed language in claims 25 and 27. Furthermore, in a telephone on June 17, 2003, Mr. Justin Karjala, has indicated to the Office that the term "having a nucleotide sequence consisting of" is meant to be interpreted as closed claim language. Therefore, in view of the duplicity of claims 25 and 26 if "having" in claim 25 was interpreted as open language and in view of the aforementioned telephone conversation, the examiner has interpreted the term "having" in claims 25 and 27 as closed claim language and claims 25 and 27 have essentially been interpreted as "[a]n isolated polynucleotide consisting of SEQ ID NO:1" and "[a]n isolated polynucleotide consisting of SEQ ID NO:3", respectively. Because the term "having" is typically interpreted as open language in claims drawn to nucleic and amino acid sequences, it is suggested that applicant clarify the scope of claimed polynucleotides by, for example, amending the term "having a nucleotide sequence consisting of" to "consisting of" in claims 25 and 27.

Claims 29 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 29 and 36 recite the phrase "a polypeptide comprising SEQ ID NO:2 *may be expressed* by a cell...". The phrase introduces an ambiguity into the claim rendering it indefinite. The phrase can also be interpreted that a polypeptide comprising SEQ ID

NO:2 will be sometimes expressed and sometimes not expressed by a cell. Amending the claim to recite the phrase "a polypeptide comprising SEQ ID NO:2 is expressed by a cell...", removes the ambiguity.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4, 8-9, 24-37 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 10/170,235 which has a common Assignee (Celera Corp.) with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

Claims 4, 8-9, 24-37 are drawn to a nucleotide sequence with either SEQ ID NO:1 or 3 encoding a polypeptide with SEQ ID NO:2, vectors, host cells and a method of making the polypeptide by culturing the host cell. The copending application 10/170,235 discloses all the polynucleotide sequences (for example SEQ ID NO:5362) as a nucleic acid array and therefore the copending application would become a prior art when once it is either published or matures into a patent. Hence, the above application anticipates claims 4, 8-9, 24-37 as written.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 4, 25-27, 31 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4, 8, 12, 16 of copending Application No. 10/170,235 (filed 6-13-02 claiming benefit of the filing date of 09/756,696, 1-10-01). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

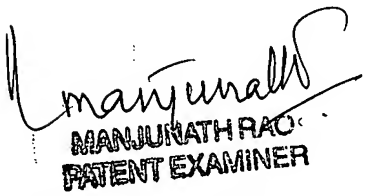
Conclusion

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.



Manjunath N. Rao
June 24, 2003